



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,148	10/12/2000	John J. Sie	19281-001000US	8622
20350	7590	06/06/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			BROWN, RUEBEN M	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/687,148	SIE ET AL.
	Examiner Reuben M. Brown	Art Unit 2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 December 2004.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 12/10/2004 have been fully considered but they are not persuasive. Applicant argues on page 7 that Proehl does not read on a first set of programs, since Proehl teaches transmission of an EPG. Examiner respectfully disagrees and points out that all of the programs in the EPG may be transmitted to the viewer, according to the schedule shown in the EPG. Furthermore, when the viewer selects a channel, the system tunes to the corresponding frequency; see col. 6, lines 1-6, which means that the programs are transmitted in real time, as claimed.

As for applicant's argument that Proehl teaches away from VOD, examiner respectfully disagrees. Simply because a viewer selects a movie that is scheduled to be broadcast at a certain time, does not mean that that is not video-on-demand. There is no teaching in Proehl that specifically contravenes the operation of Garfinkle.

As for the amended claimed feature that the counterpart in the second set of programs is substantially identical to the at least one first set of programs, the combination of the lead-in technique by Garfinkle and the EPG of Proehl meets the claims. It is pointed out that Garfinkle teaches that the 'first set of programs' are displayed as a menu/catalog, therefore the programs do exist, however Garfinkle does not discuss the old art of a "schedule" of transmission. This

feature is proved by Proehl. Thus the (lead-in and trailers) to movies transmitted and stored on the viewers receiver reads on the second of programs that have at least one copy in the first set of programs.

Since applicant did not traverse examiner's assertion of Official Notice, the corresponding statements are taken to be admitted prior art.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-16 & 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle, (U.S. Pat # 5,530,754), in view of Proehl, (U.S. Pat # 6,532, 589).

Considering claim 1, the amended claimed method for 'distributing programming comprising transmitting a first set of programs in real time' reads on the discussion in Garfinkle that upon request from a user, the central station 10 transmits the movie to the instant user site

18, see Fig. 1; col. 2, lines 8-12; col. 3, lines 25-31; col. col. 5, lines 10-18. The 'first set of programs' corresponds with the movies that are stored in the product store 12 at the central station 10, col. 2, lines 39-55; col. 4, lines 35-46.

As for the specific feature that the 'first set of programs are transmitted in real time according to a schedule of programming', Garfinkle only discusses displaying the list of programs as a menu/catalog, not as a 'schedule of programming'. However, Proehl teaches that a first set of programs (which reads on the entire schedule of programs) is transmitted to the subscriber as an EPG, (Fig. 7; col. 4, lines 10-12). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Garfinkle with the teachings of Proehl (col. 1, lines 54-67), presenting the first set of programs to the subscriber as a schedule of programs at least for the desirable advantage of providing the subscriber with the option of accessing one or more programs at specific predetermined times, i.e. when they are broadcast. Furthermore, Proehl suggests that it would have been a desirable improvement to integrate the old art of EPG, with the technology used in record and playback functions of video data recorders, col. 6, lines 61-67.

Regarding the claimed 'second set of programs stored on a server, such that at least one of the first set of programs has a counterpart in the second set of programs', in Garfinkle the video products that are downloaded and stored at the catalog memory store 22/ product store memory 24 are sent from the video product store 12, located at the central station, Abstract; col. 3, lines 5-20 & col. 4, lines 1-12. Therefore the movies (i.e., lead-in or trailer) stored in the

catalog memory store 22/product store memory 24, represent a subset of programs stored in the video product store 12, and thus read on the claimed, 'second set of programs'.

As for the further claimed feature of the second set of programs having a counterpart substantially identical to the at least one of the first set of programs, all of the lead-in programs stored in the user's receiver in Garfinkle have a counterpart on server, i.e. first set of programs. Thus combining Garfinkle with Proehl would provide the schedule of programs broadcast that a viewer could choose from, while once the selection is made, the lead-in segment is automatically played until the remainder of the program is downloaded to the viewer.

As for the specific recitation that 'each of the second set of programs is configured to be played under a user's control', Garfinkle does not discuss the details of playing the movies. Nevertheless, Official Notice is taken that at the time the invention was made, it was old in the art to provide the user with the technology, when a video program is accessed, for controlling those downloaded programs during playback, using standard trick-play functions such as Rewind, Pause, Fast Forward. It would have been obvious for one of ordinary skill in the art at the time the invention as made, to modify Garfinkle with the old art, using the trick-play technique for the known desirable benefit of allowing the subscriber to view movies with the same control features of a standard VCR system.

The additionally claimed feature of 'transmitting a notification signal to distinguish at least one of the second of programs on the server from the programs not on the server', reads on

the discussion in Garfinkle that along with the listing of video products there is an indication also transmitted, which indicates whether a particular movie stored in the video product store 12 has a corresponding 'lead-on' or trailer also stored in the catalog memory store 22/ product store memory 24, i.e. 'second set of programs', col. 3, lines 40-64.

Considering claim 2, the claimed step of identifying when a user has tuned to a particular program, corresponds with the user in Garfinkle, selecting a movie listed on a menu of video products, see col. 3, lines 25-31 & col. 4, lines 66-67. The above claimed feature also reads on the user in Proehl selecting and tuning to a channel, from the EPG, col. 5, lines 25-60 & col.

As for the additional claimed feature of when the particular program 'having a counterpart program in the schedule of programs, superimposing a notification symbol on the particular program', Garfinkle teaches that data records describing video products are transmitted to the catalog store memory 22, such that the data records includes fields 36, 38 & 40, which are flags that indicate whether a particular movie in the list of movies also contains a trailer or lead-in, col. 3, lines 32-49 & Fig. 2. The reference goes on to discuss that along with the listing of the video products on the menu, this indication may be displayed for the viewer, col. 3, lines 50-64 & Fig. 3. Nevertheless, Garfinkle does not explicitly state that a notification symbol is superimposed on the particular program. However, Proehl shows that the programs that have been recorded on the subscriber's VCR and are displayed in the EPG, include an icon 920 which reads on the claimed 'notification symbol'; see Fig. 9; col. 7, lines 50-56 & col. 8, lines 10-45. It would have been obvious for one of ordinary skill in the art at the time the invention was made,

to modify Garfinkle to use an icon to display a notification symbol, for the desirable improvement of more clearly informing the user of the status of the associated parameter.

Considering claims 3, 7, 10, 15 and 22, the combination of Garfinkle (discloses an indication) & Proehl (which uses an icon) provide a notification symbol.

Considering claims 4, 8, 11, 16 and 23, the combination of Garfinkle (discloses an indication) & Proehl (which uses an icon) provide a notification symbol, but does specifically disclose using either an 'alphanumeric string'. Official Notice is taken that at the time the invention was made, the use of an alphanumeric string, such as a word/phrase to notify a viewer of the status or condition of a parameter, was old in the art. It would have been obvious for one ordinary skill in the art at the time the invention was made, to provide the indication of lead-in or trailer parameters to the user in Garfinkle, using the old technology of an alphanumeric string, for the desirable benefit of providing a more specific and unambiguous visual confirmation, associated with the movies on the list.

Considering claims 5 & 25, the claimed feature of 'detecting a user request for descriptive information regarding a particular program and transmitting the descriptive information', is met by the discussion Garfinkle that the user may request additional information regarding video products, (col. 3, lines 55-65 & col. 4, lines 51-65). Also Proehl teaches that the user may access additional information regarding TV programming, Fig. 10 & col. 8, lines 31-55. The additionally claimed feature of 'determining whether the particular program has a

counterpart program stored on the server' corresponds with subject matter mentioned above in the rejection of claim 2 of 'identifying' and is likewise treated.

As for the further claimed recitation of 'superimposing a notification symbol on the descriptive information of the particular program if it is determined that it has a counterpart stored on the server', the disclosure in Proehl displays the same icon on the descriptive information as in the listing of programming shown in the EPG, Fig. 9 & 10. Specifically Proehl discloses that descriptive information relating to a particular program is displayed to the user, along with the icon of recorded event, which reads on the claimed 'superimposing a notification symbol on the descriptive information'. Thus in Proehl, the icon symbolizing a recorded program is only attached to a video program descriptive data, in the instance that the program has been recorded, since the instant icon is only used to notify the user that a program, has in fact been recorded.

Considering claims 6 & 26, Garfinkle teaches the use of remote control, col. 3, lines 50-54.

Considering claim 9, Garfinkle teaches that when a user requests a menu of programs, a menu of programs is provided for the instant user, col. 2, lines 8-12; col. 3, lines 20-35; col. 3, lines 54-60, also see Proehl (col. 7, lines 2-4 & col. 7, lines 55-58), which reads on the claimed feature. The additionally claimed feature of determining which shows within the menu have a

counterpart stored on the server, and superimposing at least one notification symbol on the menu to denote each program with a counterpart on the server', corresponds with subject matter mentioned above in the rejection of claim 2, and is likewise treated.

In particular, Fig. 9 of Proehl shows that programs that have been recorded, (which corresponds with the second set of programs stored on the server) have a particular icon, whereas programs that have not been recorded do not have the same icon; see col. 2, lines 35-48; col. 7, lines 45-56; col. 8, lines 10-20.

Considering claim 12, Garfinkle (col. 4, lines 51-60) & Proehl (Fig. 10; col. 5, lines 30-61) teach that the menu/EPG may contain additional information, related to the TV programming.

Considering claim 13, the menu in Garfinkle contains some movies that have a lead-in stored at the catalog memory 22/-product store memory 24, at the user site 18, which reads on the claimed subject matter. Also, the programs that have been recorded and contain a particular icon, reads on the claimed feature.

Considering claim 14, the claimed features correspond with subject matter mentioned above in the rejection of claim 9, and is likewise treated. As for the recited feature of a 'schedule of programming', as discussed above in the rejection of claim 1, Proehl reads on the claimed subject matter.

Considering claim 20, in Garfinkle the server reads on the catalog store memory 22/- product store memory 24, which is local to the user site 18 and meets the recited feature; both Garfinkle (col. 3, lines 5-25) and Proehl (col. 6, lines 61-67) disclose storing video programming in the memory, at the user site, which reads on the claimed subject matter.

Considering claim 21, the claimed feature of providing a system to transmit a set of programs to a user, at least some of which are configured to also be available under control of the user corresponds with subject matter mentioned above in the rejection of claim 1, and is likewise analyzed. In particular, Garfinkle teaches that some of the programs listed on a menu guide transmitted from a central station 10, also have a counterpart, i.e., a lead-in stored in the memory at the user site 18. If the user selects for viewing, one of the movies stored in user memory, then a notification is provided to the user, indicating that status.

Considering claim 24, the claimed method steps for distributing programming, corresponds with subject matter mentioned above in the rejection of claims 1 & 2, and is likewise treated.

4. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle & Proehl, in view of Cragun, (U.S. Pat # 5,973,683).

Considering claim 17, the claimed feature of 'transmitting a menu of programs from which a user can select a particular program to be played under control of the user', corresponds with subject matter mentioned above in the rejection of claim 1, and is likewise treated. As for the additional claimed feature of verifying that the user is authorized to access the programs on the server, Garfinkle & Proehl do not discuss any authentications procedures.

However Cragun is directed to system that restricts access to certain programming based upon authorization preferences set by an adult subscriber to the system, col. 11, lines 40. Cragun furthermore teaches that a plurality of users may be assigned a personal control unit, which requires a password to access the programming, col. 11, lines 1-3. It would have been obvious for one ordinary skill in the art at the time the invention was made, to modify Garfinkle with the teaching of requiring authorization to access certain programming, at least for the desirable improvement of allowing a parent to electronically control the content viewed by their children, as taught by Cragun, col. 1, lines 21-42; col. 6, lines 1-31.

Considering claim 18, it would have been obvious for one of ordinary skill in the art at the invention was made, to operate the system of Garfinkle & Cragun in manner that the access to programs are verified after the menu of programs is transmitted, at least in order to ensure that the user is authorized for the proper set of programs. As for the recited feature 'wherein the menu of programs identifies only the programs stored on the server', Cragun teaches that the system may operate to provide a list of only the programs that a particular user is authorized to view,

which corresponds with providing the user with a list of only the set of programs that are on the server, which are the programs the user is authorized to view, as recited in the claim. It would have been obvious for one ordinary skill in the art at the time the invention was made, to modify Garfinkle with the technique of providing a list of only programs that a user is authorized to view, for the desirable improvement of avoiding the user being frustrated because he/she sees programs listed on a menu, which the user is prohibited from accessing, as disclosed by Cragun, col. 10, lines 36-60.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle & Proehl, in view of Lawler, (U.S. Pat # 5,585,838).

Considering claim 19, both Garfinkle (col. 3, lines 10-25) and Proehl (col. 6, lines 61-67) disclose storing video programming in the memory, at the user site, instead of remote from the user as recited in the claims. However, Lawler teaches that the user may store video programs at a headend remote from the user, as an alternative to storing in the local VCR device, (col. 14, lines 1-15). It would have been obvious for one ordinary skill in the art at the time the invention was made, to modify the Garfinkle, to store video programming at the head-end as discussed by Lawler, at least in order to take advantage of devices with more storage capacity.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Any response to this action should be mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

**or faxed to:**

(703) 872-9306, (for formal communications intended for entry)

**Or:**

(703) 746-6861 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown



CHRIS GRANT  
PRIMARY EXAMINER